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Atty. Dkt. No. 051373-0126

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Mark Miller Chesser	<p><b>CERTIFICATE OF FACSIMILE TRANSMISSION</b></p> <p>I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below.</p> <p><i>Todd A. Rathe</i> (Printed Name)</p> <hr/> <p><i>/Todd A. Rathe/</i> (Signature)</p> <hr/> <p>10/29/2007 (Date of Deposit)</p>
Title: METHOD, APPARATUS, SIGNALS AND MEDIA FOR PROVIDING CUSTOM OUTPUT IN RESPONSE TO USER INPUT AND E-MAIL SYSTEM EMPLOYING SAME	
Appl. No.: 09/755,898	
Filing Date: 01/05/2001	
Examiner: Doan, Duyen My	
Art Unit: 2143	

**BRIEF ON APPEAL**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**1. Real Party in Interest**

The real party in interest is Infowave Software, Inc., a British Columbia company corporation having a principal place of business at 4664 Lougheed hwy, Suite 200, Burnaby, BC.

**2. Related Appeals and Interferences**

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellants or Appellants' patent representative.

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### 3. Status of Claims

Claims 1-43 were originally pending in the application. In response to a first substantive Office Action mailed on November 5, 2004, Appellants canceled to claims 2, 21, 38 and 39; amended claims 1, 3, 4, 20, 22, 37 and 41 and added claims 44 and 45. In response to a Final Office Action mailed on June 16, 2005, Appellants filed an RCE with a response amending claims 1, 12, 13, 15, 20, 29, 30, 32, 33, 40 and 41. In response to an Office Action mailed on February 27, 2006, Appellants canceled claims 7-11, 15, 26-28 and 31-33 and added claims 46-60. The present appeal follows the Final Office Action mailed on May 25, 2007 and is directed to claims 1, 3-6, 12-14, 16-20, 22-25, 29-30, 34-37 and 40-60, i.e., all of the presently pending claims that stand rejected in this application.

### 4. Status of Amendments

An amendment is being filed under 37 CFR 41.33(b) on the same day herewith canceling claims 48, 49, 53, 54, 58 and 59 to reduce the number of issues on appeal.

### 5. Summary of Claimed Subject Matter

As discussed in the Specification, a wireless device 50 accesses a server 18 via a communication network 30, such as the Internet. See, Figure 1, Specification, page 3, lines 4-14. The server 18 includes a web interface to permit input codes associated with user entry buttons of the wireless device to be received from the wireless device 50 via the Internet 30. See, Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21. Each user entry button on the wireless device 50 may be associated with user-specified output characters stored in a programmable device 12 of server 18. See, Figures 4 and 5, Specification, page 3, lines 6-12, page 6, lines 22-27, page 8, lines 18-21 and page 9, lines 19-23. When a user entry button is activated on the wireless device, a user-specified output character(s) previously associated with the user entry button is provided. See, Specification, page 11, line 28 to page 12, line 1. Accordingly, the system allows a users to specify their own custom output for user

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entry buttons on the wireless device and provide a degree of customization to the use of the Internet-enabled wireless device. See, Specification, page 2, lines 6-9, page 3, lines 12-15, page 6, lines 18-29 and page 9, lines 19-23.

A. Claims 1, 20 and 37

Claim 1 is directed to a method of producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons. The method includes

a) receiving an input code from the wireless Internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button (See Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21);

b) locating in a programmable device at least one user-specified output character associated with the user entry button, in response to receipt of the input code, the programmable device storing a plurality of user-specified output characters associated with the plurality of user entry buttons (See Specification, page 11, line 28 to page 12, line 1); and

c) providing said at least one user-specified output character for use by an application program (Specification, page 11, line 28 to page 12, line 1).

Claim 20 is directed to an apparatus for producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons. The apparatus includes:

a) a receiving interface operable to receive an input code from the wireless Internet-enabled device via a data communications network, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button (See Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 11, line 4, page 9, lines 7-11 and page 10, lines 20-21);

b) a programmable device coupled to the receiving interface and storing at least one user-specified output character associated with the user entry button (See Specification, page 11, line 28 to page 12, line 1); and

c) a processor circuit coupled to the receiving interface and the programmable device, the processor circuit operable to locate in said programmable device at least one user-specified output character associated with the user entry button in response to receipt of the input code and operable to provide said at least

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one user-specified output character for use by an application program buttons (See Specification, page 11, line 28 to page 12, line 1).

Claims 37 is directed to an apparatus for producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons. The apparatus includes:

a) means for receiving an input code from the wireless Internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button (See Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21);

b) means for storing at least one user-specified output character associated with the user entry button buttons (See Specification, page 11, line 28 to page 12, line 1);

c) means for locating in said means for storing at least one user-specified output character associated with the user entry button, in response to receipt of the input code representing said user entry button buttons (See Specification, page 11, line 28 to page 12, line 1); and

d) means for providing said at least one user-specified output character for use by an application program buttons (See Specification, page 11, line 28 to page 12, line 1).

B. Claims 40 and 41

Claim 40 is directed to an apparatus for producing user-defined output characters in response to input codes produced by a web-communicating input device having a plurality of user entry buttons where each user entry button is associated with an input code. The system includes a web server operable to establish communications with said web-communicating input device using the World Wide Web and programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons for use in a field of an e-mail produced by an e-mail server in communication with said web server, in response to receipt by said web server of an input code associated with the user entry button, from said web-communicating input device. (See Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21).

Claim 41 is directed to an e-mail system including:

a) a web server operable to establish communications with web-communicating input devices using the World Wide Web, each web-communicating input device having a plurality of user entry buttons (See Figures 1 and 2,

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Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21);

b) an e-mail server operable to communicate with said web server (page 6, lines 4-10); and

c) at least one of said web server and said e-mail server being programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons of one of the web-communicating input devices for use in a field of an e-mail in response to receipt of an input code associated with the user entry button from one of said web-communicating input devices. (Page 6, lines 18-29).

C. Claims 46, 51 and 56

Claim 46 depends from claim 1 and recites that the application program provides a users a prompt for text input at the wireless internet-enabled device, wherein the input code is received as a response to the prompt at the wireless internet-enabled device. Claim 46 further recites that the response is transmitted to the application program after the at least one user-specified output character is substituted in place of the received input code for the response. (See Specification, page 11, line 28-page 12, line 5).

Claim 51 depends from Claim 20 and recites that an application program provides a user with a prompt for text input at the wireless internet-enabled device and that the input code is received as a response to the prompt at the wireless internet enabled device. Claim 51 further recites that the processor circuit is configured to transmit the response to the application program after the processor circuit substitutes the least one users-specified output character in place of the received input code for the response. (See Specification, page 11, line 28-page 12, line 5).

Claim 56 depends from claim 41 and recites that the e-mail server provides a user with a prompt for text input at the web communicating device, wherein the input code is received as a response to the prompt at the web communicating device. Claim 56 further recites that the web server is configured to transmit the response to the e-mail server after the web server substitutes the at least one user-specified

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output character in place of the received input code for the response. (See Specification, page 11, line 28-page 12, line 5).

In short, each of added claims 46, 51 and 56 recites that the input code is entered as a response to a prompt provided by an application program or e-mail server. Each of such claims further recites that the at least one user-specified output character is substituted in place of the received input code prior to the response being transmitted back to the application program. (See Specification, page 11, line 28-page 12, line 5).

**D. Claims 47, 52 and 57**

Claims 47, 52 and 57 depend from claims 46, 51 and 56, respectively. Each of such claims recites that the response is displayed by the application program or the e-mail server on the wireless Internet-enabled device or the web-communicating input device with the substituted at least one user-specified output character. (See Specification, page 11, line 20-page 12, line 5).

**E. Claims 50, 55 and 60**

Claim 50, 55 and 60 depend from claims 1, 20 and 41, respectively. Each of such claims recites that the input code is not transmitted to the application program. (Specification, page 11, line 28-page 12, line 1).

**6. Grounds of Rejection to be Reviewed on Appeal**

The issues on appeal are (1) whether the Examiner erred in rejecting claims 50, 55 and 60 under 35 USC 112, first paragraph and (2) whether the Examiner erred in rejecting claims 1, 3-6, 12 and 14, 16-20, 22-25, 29, 30, 37 and 40-60 under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6295346 (Markowitz et al.) in view of US Patent No. 6751603 (Bauer).

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## 7. Argument

### I. Legal Standards

#### A. Law Regarding the Written Description Requirement

Claims 50, 55 and 60 have been rejected as failing to meet the written description requirement under 35 USC Section 112, first paragraph which states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

With regard to the written description requirement, MPEP 2163 states:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

....

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing

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distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 526 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it"). "Compliance with the written description requirement is essentially a fact-based inquiry that will 'necessarily vary depending on the nature of the invention claimed.'" *Enzo Biochem*, 323 F.3d at 963, 63 USPQ2d at 1613.

There is no *in haec verba* requirement, newly added claim limitations may be supported in the specification through express, implicit, or inherent disclosure. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

B Law Under 35 USC 112, Second Paragraph

Claims 50, 55 and 60 have been rejected under 35 USC 112,. Second paragraph which states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

MPEP 2173.05(i) summarizes the current state of the law as follows:

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-



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butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

C. Law of Obviousness

Claims 1, 3-6, 12-14, 16-20, 22-25, 29, 30, 37 and 40-60 are rejected under 35 U.S.C. § 103(a), which states:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1963).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the "factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001). Further, it "must be based on objective evidence of record." In re Lee, 277 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant's disclosure. In re Vaack, 947 F.2d 488 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). "It is improper, in determining whether a

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person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)). Teaching away from the claimed invention is a strong indication of non-obviousness and an improper combination of references. U.S. v. Adams, 383 U.S. 39 (1966).

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**II. The Examiner's Rejection of Claims 50, 55 and 60 under 35 U.S.C. § 112, first paragraph Should Be Reversed Because the Originally Filed Specification Evidences Possession of the Set Forth Invention.**

The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. The burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an Appellant's disclosure a description of the invention defined by the claims rests with the examiner. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. The Examiner has failed to satisfy this burden. Accordingly, the rejection of the claims under 35 U.S.C. § 112, first paragraph is improper and should be reversed.

The Examiner rejected claims 50, 55 and 60 under 35 USC 112, first paragraph as allegedly containing subject matter not described in the specification. In particular, claims 50 count 50 and 55 each recite that "the input code is not transmitted to the application program". The Examiner asserts that this limitation is not found in the specification.

However, in contrast the assertion made by the Examiner, the specification does indeed provide support for the recitation that "the input code is not transmitted to the application program." Page 11, line 28-page 12, line 1 of the Specification specifically recites that output characters are substituted for the input code before the transmission to the application program. Page 11, line 28-page 12, line 1 of the Specification specifically states:

Thus, when a subscribing user presses a user entry button on his or her wireless device 50, a character, characters and/or linguistic phrase previously associated with such user entry button is provided to the application program 24 as a substitute for the code normally produced by the wireless device.

Accordingly, this part of the specification describes a process wherein the output code is specifically substituted in place of the input code prior to being

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transmitted to the application program. Obviously, if the output code is substituted in place of the input code, the input code cannot be transmitted to the application program.

It is well settled law that there is no *in haec verba* requirement, newly added claim limitations may be supported in the specification through express, implicit, or inherent disclosure. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 69 USPQ2d at 1117. In the present case, the Specification clearly describes the output code being substituted for the input code such that input code is not transmitted to the application program. Accordingly, the rejection of claims 50, 55 and 60 under 35 USC 112, first paragraph is improper and should be reversed.

**II. The Examiner's Rejection of Claims 50, 55 and 60 under 35 U.S.C. § 112, Second paragraph Should Be Reversed Because One of Ordinary Skill in the Art Would Understand the Meets and Bounds of the Claims.**

Claims 50, 55 and 60 each recite that the input code is not transmitted to the application program.

The Examiner rejected claim 50, 55 and 60 based on the assertion that :

applicant defined the invention in terms of what it was not, rather than pointing out the invention, but, limitations ... "the input code is not transmitted to the application program" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent.

(Final Office Action dated May 25, 2007, page 4-5). The Examiner's basis for rejecting claims 50, 55 and 60 appears to be based solely on the fact that such claims are alleged to constitute negative limitations.

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However, it is well settled law that there is nothing inherently wrong with negative claim limitations. As noted above, the limitations are claims 50 count 55 and 60 are found in the specification. One of order still the art would clearly understand the meets and bounds of claims 50 count 55 and 60. One of ordination on the art would understand what is meant when they claim recites that the input code is not transmitted to the application program. This would especially be clear in light of the specification which recites that the output code is substituted in place of the input code, thus preventing the input code from being transmitted to the application program. Accordingly, the rejection of claims 50 count 55 and 60 under 35 USC 112, second paragraph is improper and should be reversed.

**III. The Examiner's Rejection of Claims 1, 3-6, 12-14, 16-20, 22 and 20 5, 29, 30, 37, 40-47, 50-52, 55 -57 and 60 under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6295346 (Markowitz et al.) in view of US Patent No. 6751603 (Bauer) Should be Reversed Because It Would Not Be Obvious to Modify Kadyk in view of Steele so As to Include Every Limitation of Each of the Claims.**

**A. Claims 1, 20 and 37**

Claim 1 is directed to a method of producing custom output in response to user input and recites, among other limitations:

- a) receiving an input code from the wireless Internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;
- b) locating in a programmable device at least one user-specified output character associated with the user entry button, in response to receipt of the input code, the programmable device storing a plurality of user-specified output characters associated with the plurality of user entry buttons;

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Claim 20 is directed to an apparatus for producing custom output in response to user input and recites, among other limitations:

- a) a receiving interface operable to receive an input code . . . the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;
- b) a programmable device . . . storing at least one user-specified output character associated with the user entry button; and
- c) a processor circuit . . . operable to locate in said programmable device at least one user-specified output character associated with the user entry button . . .

Claim 37 is directed to an apparatus for producing custom output in response to user input and recites, among other limitations:

- a) means for receiving an input code . . . the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;
- b) means for storing at least one user-specified output character associated with the user entry button;
- c) means for locating . . . at least one user-specified output character associated with the user entry button, in response to receipt of the input code representing said user entry button;

As discussed in the specification, a wireless device 50 accesses a server 18 via a communication network 30, such as the Internet. See, Figure 1, Specification, page 6, lines 4-14. The server 18 includes a web interface to permit input codes associated with user entry buttons of the wireless device to be received from the wireless device 50 via the Internet 30. See, Figures 1 and 2, Specification, page 3, lines 6-12, page 7, line 25 to page 8, line 4, page 9, lines 7-11 and page 10, lines 20-21. Each user entry button on the wireless device 50 may be associated with user-specified output characters stored in a programmable device 12 of server 18. See,

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Figures 4 and 5, Specification, page 3, lines 6-12, page 6, lines 22-27, page 8, lines 18-21 and page 9, lines 19-23. When a user entry button is activated on the wireless device, a user-specified output character(s) previously associated with the user entry button is provided. See, Specification, page 11, line 28 to page 12, line 1. Accordingly, the system allows a users to specify their own custom output for user entry buttons on the wireless device and provide a degree of customization to the use of the Internet-enabled wireless device. See, Specification, page 2, lines 6-9, page 3, lines 12-15, page 6, lines 18-29 and page 9, lines 19-23.

Neither Markowitz nor Bauer, alone or in combination, teach, suggest or disclose, associating at least one user-specified output character with a user entry button on a wireless Internet-enabled device, storing a plurality of user-specified output characters associated with the plurality of user entry buttons or locating at least one user-specified output character associated with a user entry button. In contrast, Markowitz merely discloses an emergency notification system for a phone, wherein notifications are automatically sent to selected parties by the phone system (Local Exchange Carrier (LEC) switches) when a person dials the phone number of an emergency service provider. Markowitz does not disclose receiving an input code from a wireless Internet enabled device via a web interface of a server computer.

The Examiner acknowledges that Markowitz fails to disclose receiving an input code from a wireless Internet-enabled device via a web interface of a server computer. As a result, the Examiner attempts to additionally rely upon Bauer for this feature. However, in contrast to the Examiner's assertion, it would not be obvious to modify Markowitz based on Bauer.

In an attempt to establish a prima facie case of obviousness, the Examiner asserts that:

it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Bauer to the method of Markowitz to use the artless Internet enabled device via a web interface of a server computer because by using the wireless device to input the code through the interface of the server computer would accelerate and facilitate the process of



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finding datafile in a computer system (see Bauer col.1, lines 8-21).

(Office Action, page 3). However, this alleged motivation for modifying Markowitz based on Bauer lacks merit. Markowitz has **nothing** to do with finding a data file in a computer system. Nowhere does Markowitz indicate that it even relates to "the process of finding data file in a computer system". Since Markowitz has nothing to do with finding a data file in a computer system, one of ordinary skill in the art would have no reason to modify Markowitz for this reason.

Moreover, since the explicit purpose of Markowitz is to facilitate the notification of parties when a phone call is placed to an emergency service provider, it would make little sense to somehow replace the phone and local exchange carrier (LEO) switches disclosed by Markowitz with a wireless Internet-enabled device communicating via a web interface every server computer. Persons contacting an emergency service provider, such as a fire department, a police station and the like, would not normally use a web interface. Thus, the rejection based on the combination of Markowitz and Bauer should be withdrawn.

Claims 3-6, 12-14, 16-19 and 44 depend from claim 1 and incorporate all of the limitations of amended claim 1 and are therefore allowable over Markowitz in view of Bauer for, among other reasons, the same reasons as given above with respect to amended claim 1. Claims 22-25, 29-30, 34-36 and 45 depend from claim 20 and incorporate all of the limitations of amended claim 20 and are therefore allowable over Markowitz in view of Bauer for, among other reasons, the same reasons as given above with respect to claim 20.

**B. Claims 40 and 41**

Independent claim 40 is directed to an apparatus for producing user-specified output characters in response to input codes and recites, among other limitations a web server programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons in response to receipt of an input code associated with the user entry button.

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Independent claim 41 is directed to an e-mail system and recites, among other limitations:

a) a web server operable to establish communications with web-communicating input devices using the World Wide Web, each web-communicating input device having a plurality of user entry buttons; . . .

c) at least one of said web server and said e-mail server being programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons of one of the web-communicating input devices . . . in response to receipt of a input code associated with the user entry button. . .

Neither Markowitz nor Bauer, alone or in combination, disclose or suggest a web communicating input device for entry of input codes using user entry buttons and the transmission of such input codes using the World Wide Web to produce at least one user-specified output character in a field of an e-mail. As noted above, the Examiner acknowledges that Markowitz fails to disclose the use of a wireless Internet-enabled device or a web interface of a server computer. As a result, the Examiner attempts to additionally rely upon Bauer to satisfy this acknowledged efficiency of Markowitz.

However, as noted above, motivation alleged by the Examiner for modifying Markowitz based on Bauer is devoid of merit. Since Markowitz has nothing to do with locating a datafile on a computer, one of ordinary skill in the art would not be led to modify Markowitz based on Bauer for this reason. Moreover, as also noted above, since the explicit purpose of Markowitz is to notify parties in response to a call being made to an emergency service provider, it would not be obvious to somehow replace the phone and local exchange carrier (LEC) switches disclosed by Markowitz with a wireless Internet-enabled device communicating via a web interface every server computer. Persons contacting an emergency service provider, such as a fire department, a police station and the like, would not normally use a web interface. Thus, the rejection of claims 40 and 41 should be withdrawn.

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Claims 42 and 43 depend from claim 41 and incorporate all of the limitations of amended claim 41 and are therefore allowable over Markowitz in view of Bauer for, among other reasons, the same reasons as given above with respect to claim 41.

C. Claims 46, 51 and 56

Claim 46 depends from claim 1 and recites that the application program provides a user a prompt for text input at the wireless internet-enabled device, wherein the input code is received as a response to the prompt at the wireless internet-enabled device. Claim 46 further recites that the response is transmitted to the application program after the at least one user-specified output character is substituted in place of the received input code for the response.

Claim 51 depends from Claim 20 and recites that an application program provides a user with a prompt for text input at the wireless internet-enabled device and that the input code is received as a response to the prompt at the wireless Internet enabled device. Claim 51 further recites that the processor circuit is configured to transmit the response to the application program after the processor circuit substitutes the least one users-specified output character in place of the received input code for the response.

Claim 56 depends from claim 41 and recites that the e-mail server provides a user with a prompt for text input at the web communicating device, wherein the input code is received as a response to the prompt at the web communicating device. Claim 56 further recites that the web server is configured to transmit the response to the e-mail server after the web server substitutes the at least one user-specified output character in place of the received input code for the response. Support for added claims 46, 51 and 56 may be found in at least page 11, line 28-page 12, line 5. Thus, no new matter is believed to be added.

In short, each of added claims 46, 51 and 56 recites that the input code is entered as a response to a prompt provided by an application program or e-mail server. Each of such claims further recites that the at least one user-specified output

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character is substituted in place of the received input code prior to the response being transmitted back to the application program.

Neither Markowitz or Bauer, alone or in combination disclose transmitting a response back to an application program, wherein at least one user-specified output character is substituted in place of the entered input code. Markowitz does not disclose substituting a user-specified output character in place of an input code entered as a response to a prompt before the response is returned to the application program. With Markowitz, the entry of a phone number of an emergency service provider simply triggers additional notifications. In Markowitz, when a person enters a the phone number of an emergency service provider, that phone number is not discarded and replaced with a user-specified output character. Rather, the phone number of the emergency service provider that is entered is used by the local exchange carrier to connect to the emergency service provider.

In response to such points, the Examiner repeats his mischaracterization of what is actually taught by Bauer. The Examiner asserts that Bauer discloses that a user-specified output character is substituted in place of the received input code. (See Final Office action, page 10). However, this is not true. Nowhere does Bauer disclose that they originally filed emergency phone number is replaced or substituted with a different output character.

In fact, it would make absolutely no sense to substitute an output character for the originally filed emergency phone number in Bauer. Obviously, Bauer does NOT teach that when a person dials the phone number of the fire department that the person's other contacts (e.g. his or her brother, parents or the like) are substituted in place of the fire department's phone number such that the fire department is never contacted. This would potentially result in a tragedy. Thus, the rejection of claims 46, 51 of 56 based upon Markowitz and Bauer should be reversed.

D. Claims 47, 52 and 57

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Claims 47, 52 and 57 depend from claims 46, 51 and 56, respectively. Each of such claims recites that the response is displayed by the application program or the e-mail server on the wireless Internet-enabled device or the web-communicating input device with the substituted at least one user-specified output character.

Neither Markowitz nor Bauer, alone or in combination, disclose displaying a substituted user-specified output character on the wireless internet-enabled device or the Web-communicating input device. For example, Markowitz does not disclose that the notification message is ever presented on the phone in which the emergency provider phone number is entered. Moreover, since a notification message is not substituted in place of the emergency provider phone number, such display of the notification message would not be inherent. Thus, the rejection of claims 47, 52 and 57 should be reversed.

E. Claims 50, 55 and 60

Claim 50, 55 and 60 depend from claims 1, 20 and 41, respectively. Each of such claims recites that the input code is not transmitted to the application program.

Neither Markowitz nor Bauer, alone or in combination, disclose the method, the apparatus or the e-mail system of claims 1, 20 and 41, wherein the input code is not transmitted to the application program. For example, Markowitz specifically requires that the entered emergency phone number be forwarded to the local exchange carrier to make a connection to the emergency service provider. To not forward the entered the emergency phone number to the logical exchange carrier in such an emergency would completely contradict the purpose of Markowitz and would potentially result in a tragedy. Thus, the rejection of claims 50, 55 and 60 should be reversed.

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**Conclusion**

In view of the foregoing, the Appellants submit that Claims 50, 55 and 60 are not properly rejected under 35 USC 112, first paragraph. Claims 50, 55 and 60 are not properly rejected under 35 USC 112, second paragraph. Claims 1, 3-6, 12 and 14, 16-20, 22-25, 29, 30, 37 and 40-60 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6295346 (Markowitz et al.) in view of US Patent No. 6751603 (Bauer) and are therefore patentable. Accordingly, Appellants respectfully request that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

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Summary

For the foregoing, it is submitted that the Examiner's rejections are erroneous, and reversal of the rejections is respectfully requested.

Dated this 29th day of October, 2007.

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**CLAIMS APPENDIX**

1. (Previously Presented) A method of producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons, the method comprising:

a) receiving an input code from the wireless Internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;

b) locating in a programmable device at least one user-specified output character associated with the user entry button, in response to receipt of the input code, the programmable device storing a plurality of user-specified output characters associated with the plurality of user entry buttons; and

c) providing said at least one user-specified output character for use by an application program.

2. (Canceled)

3. (Previously Presented) The method of claim 1 wherein receiving said input code via a web interface comprises receiving the input code from a data communications network.

4. (Previously Presented) The method of claim 3 wherein receiving said input code from a data communications network comprises receiving said input code from a communications system in communication with the wireless Internet-enabled device and the data communications network.

5. (Original) The method of claim 4 wherein receiving said input code from a communications system comprises receiving said input code from a wireless communications system.

6. (Previously Presented) The method of claim 5 wherein the wireless Internet-enabled device is a wireless telephone.

7. (Canceled)

8. (Canceled)

9. (Canceled)

10. (Canceled)

11. (Canceled)



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12. (Previously Presented) The method of claim 1 further comprising programming said programmable device by associating at least one output character with a corresponding input code and its associated user entry button.

13. (Previously Presented) The method of claim 12 wherein programming comprises associating linguistic phrases with corresponding input codes and the associated user entry buttons.

14. (Original) The method of claim 12 wherein programming comprises receiving said at least one user-specified character from a user input device.

15. (Canceled)

16. (Original) The method of claim 12 further comprising presenting a programming interface to a user, to facilitate receiving said programming commands.

17. (Original) The method of claim 12 further comprising relating a set of input codes and corresponding output characters to a user.

18. (Original) The method of claim 17 wherein relating comprises relating sets of input codes and corresponding output characters to corresponding users.

19. (Original) The method of claim 17 wherein producing comprises locating a set of input codes and corresponding output characters, corresponding to a user determined from said input code.

20. (Previously Presented) An apparatus for producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons, the apparatus comprising:

a) a receiving interface operable to receive an input code from the wireless Internet-enabled device via a data communications network, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;

b) a programmable device coupled to the receiving interface and storing at least one user-specified output character associated with the user entry button; and

c) a processor circuit coupled to the receiving interface and the programmable device, the processor circuit operable to locate in said programmable device at least one user-specified output character associated with the user entry button, in response to receipt of the input code and operable to provide said at least one user-specified output character for use by an application program.

21. (Canceled)

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22. (Previously Presented) The apparatus of claim 20 wherein said receiving interface further comprises a web interface for receiving said input code from the data communications network.

23. (Original) The apparatus of claim 22 wherein said web interface is configured to cooperate with a communications system to receive said input code.

24. (Original) The apparatus of claim 22 wherein said web interface is configured to cooperate with a wireless communications system to receive said input code.

25. (Previously Presented) The apparatus of claim 22 wherein the wireless Internet-enabled device is a wireless telephone.

26. (Canceled)

27. (Canceled)

28. (Canceled)

29. (Previously Presented) The apparatus of claim 20 wherein the processor circuit is operable to program said programmable device to associate at least one output character with a corresponding input code and its associated user entry button.

30. (Previously Presented) The apparatus of claim 29 wherein said processor circuit is operable to associate linguistic phrases with corresponding input codes and the associated user entry buttons.

31. (Canceled)

32. (Canceled)

33. (Canceled)

34. (Original) The apparatus of claim 29 wherein said processor circuit is operable to relate a set of input codes and corresponding output characters to a user.

35. (Original) The apparatus of claim 29 wherein said processor circuit is operable to relate sets of input codes and corresponding output characters to corresponding users.

36. (Original) The apparatus of claim 29 wherein said processor circuit is programmed to locate a set of input codes and corresponding output characters, corresponding to a user determined from said input code.

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37. (Previously Presented) An apparatus for producing custom output in response to user input received using a wireless Internet-enabled device having a plurality of user entry buttons, the apparatus comprising:

a) means for receiving an input code from the wireless Internet-enabled device via a web interface of a server computer, the input code associated with one of the plurality of user entry buttons and representing user input provided at the wireless Internet-enabled device by activation of the user entry button;

b) means for storing at least one user-specified output character associated with the user entry button;

c) means for locating in said means for storing at least one user-specified output character associated with the user entry button, in response to receipt of the input code representing said user entry button; and

d) means for providing said at least one user-specified output character for use by an application program.

38. (Canceled)

39. (Canceled)

40. (Previously Presented) An apparatus for producing user-defined output characters in response to input codes produced by a web-communicating input device having a plurality of user entry buttons where each user entry button is associated with an input code, the system comprising a web server operable to establish communications with said web-communicating input device using the World Wide Web and programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons for use in a field of an e-mail produced by an e-mail server in communication with said web server, in response to receipt by said web server of an input code associated with the user entry button, from said web-communicating input device.

41. (Previously Presented) An e-mail system comprising:

a) a web server operable to establish communications with web-communicating input devices using the World Wide Web, each web-communicating input device having a plurality of user entry buttons;

b) an e-mail server operable to communicate with said web server;

c) at least one of said web server and said e-mail server being programmed to produce at least one user-specified output character associated with one of the plurality of user entry buttons of one of the web-communicating input devices for use in a field of an e-mail in response to receipt of an input code associated with the user entry button from one of said web-communicating input devices.

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42. (Original) The e-mail system of claim 41 wherein said web server and said e-mail server are implemented on a common computer.

43. (Original) The e-mail system of claim 41 wherein said web server and said e-mail server are implemented on separate computers.

44. (Previously Presented) The method of claim 3 wherein the data communications network is the Internet.

45. (Previously Presented) The apparatus according to claim 20 wherein the data communications network is the Internet.

46. (Previously Presented) The method of claim 1 further comprising:  
the application program providing a user with a prompt for text input at the wireless Internet enabled device, wherein the input code is received as a response to the prompt at the wireless internet enabled device; and  
transmitting the response to the application program after the at least one user-specified output character is substituted in place of the received input code for the response.

47. (Previously presented) The method of claim 46, wherein the response is displayed by the application program on the wireless internet-enabled device with the substituted at least one user-specified output character.

48. (Previously Presented) The method of claim 47, wherein the input code excludes a phone number.

49 (Previously Presented) The method of claim 1, , wherein the input code excludes a phone number.

50. (Previously Presented) The method of claim 1, wherein the input code is not transmitted to the application program.

51. (Previously Presented) The apparatus of claim 20 further comprising:

an application program providing a user with a prompt for text input at the wireless Internet enabled device, wherein the input code is received as a response to the prompt at the wireless internet enabled device;

wherein the processor circuit is configured to transmit the response to the application program after the processor circuit substitutes the at least one user-specified output character in place of the received input code for the response.

52. (Previously Presented) The apparatus of claim 51, wherein the application program is configured to display the response on the wireless internet-enabled device with the substituted at least one user-specified output character.

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53. (Previously Presented) The apparatus of claim 52, wherein the input code excludes a phone number.

54. (Previously Presented) The apparatus of claim 20, wherein the input code excludes a phone number.

55. (Previously Presented) The apparatus of claim 20, wherein the input code is not transmitted to the application program.

56. (Previously Presented) The e-mail system of claim 41,

wherein the e-mail server provides a user with a prompt for text input at the web communicating input devices, wherein the input code is received as a response to the prompt at the Web communicating input devices; and

wherein the web server is configured to transmit the response to the e-mail server after the processor circuit substitutes the at least one user-specified output character in place of the received input code for the response.

57. (Previously Presented) The e-mail system of claim 56, wherein the e-mail server is configured to display the response on the Web communicating input devices with the substituted at least one user-specified output character.

58. (Previously Presented) The e-mail system of claim 57, wherein the input code excludes a phone number.

59. (Previously Presented) The e-mail system of claim 56, wherein the input code excludes a phone number.

60. (Previously Presented) The e-mail system of claim 56, wherein the input code is not transmitted to the e-mail server.

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### **EVIDENCE APPENDIX**

There is no evidence previously submitted under 37 C.F.R. §§ 1.130, 1.131 or 1.132 or other evidence entered by the Examiner and relied upon by Appellant in this appeal. Accordingly, the requirements of 37 C.F.R. §§ 1.37(c)(1)(ix) are satisfied.

### **RELATED PROCEEDINGS APPENDIX**

There are no decisions rendered by a Court of the Board in a proceeding identified in the Related Appeals and Interferences section. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(x) are satisfied.